UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,642	01/22/2004	David Howell	352544-991100	2449

26379   7590   07/16/2008
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

EXAMINER
BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
07/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-36* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *22 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
        Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
        Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

This Office Action is in response to an amendment filed 04/11/2008.

Claims 1-36 remain pending. Claims 1, 13, and 25 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 10, 13-19, 22, 25-31 and 34 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Clark et al. (hereinafter Clark, U.S. Patent No. 6,704,733 files

09/26/2001, issued 03/09/2004) in view of Levine (U.S. Patent App. No. 2004/0205462

filed 01/07/2002, published 10/14/2004).

In regard to independent Claim 1, <u>Clark</u> discloses:

- *A system for collecting and distributing an edition of a work* (Abstract → a method

  for receiving, processing, and distributing electronic content), *comprising:*

    o *an input module that receives an input file in a particular format* (Col. 3,

      line 62 through Col. 4, line 42; Fig. 4; Col. 6, lines 47-54; Fig. 12 → a

      publisher transmits content over a network to a server for subsequent

      electronic distribution and/or hard copy printing. In addition to content, the

      server can also receive metadata corresponding to the content. Inputted

content can be in a variety of formats such as PDF, PostScript,

QuarkXpress, etc.), *the input module further comprising*

- *a module that validates the input file* (Col. 6, line 63 through Col. 7,

  line 7 → after receiving the content and metadata, the process

  (240) automatically checks (pre-flights) (*validates*) the content for

  numerous issues which might prevent accurate automatic

  preparation of a title (*a work*)).

Clark fails to disclose:

- *converts the input file into an intermediate format file.* Clark keeps

  the input file format and merely converts that to a desired output

  format.

However, Levine discloses … *converts the input file into an*

intermediate format file (at least Pgs. 1-2, Paragraphs [0014-0025]; Figs.

1-3 → Levine, as depicted in Figure 1, takes as input either a digital

version of an original book or a scanned hard copy of a book, and

converts the book files to a *solution-independent intermediate format*.

It would have been obvious to one of ordinary skill in the art at the time

of invention to combine the disclosures of Clark and Levine as both

inventions are related to the electronic dissemination of documents such

as books. Adding the disclosure of Levine provides the benefit to Clark of

creating and providing a "generic" version of the document from which

multiple other forms and formats of output can be generated.

Clark further discloses:

o *a storage device comprising*

- *a storage portion into which a piece of work metadata associated with the input file is stored* (Col. 4, lines 20-22, Fig. 4 → server contains a content management system that stores and processes the received content and metadata).

It is noted that the phrase *"work metadata"* is defined in the Specification as a combination of *"metadata related to the work itself"* and *"metadata related to the final forms that the work might assume,"* where a *"work"* is understood to collectively describe the original input document file(s).

Clark summarizes the "metadata" accompanying input documents as including identifier information such as the ISBN, UPC or DOI of the work; pricing information for one or more markets in which the work may be sold; bibliographic information such as the author and title of the work; distribution information such as identification of territories where selling the work is authorized, retailers authorized to sell the work, and/or identification of one or more digital rights management systems for protecting the work when distributed electronically; and/or manufacturing information, such as a printing and/or binding specifications, for use in the preparation of hard copies of the work. (See Col. 2, lines 4-10; Col. 3, lines 1-13).

This language is interpreted as describing both the "metadata related

to the work itself" (e.g. identifier information, bibliographic information) and

the *"metadata related to the final forms that the work might assume"*

portion (e.g. DRM, manufacturing information) of the *"work metadata"* as

defined by the Specification.

Thus, Clark further teaches *"work metadata"* accompanying the

documents.

Clark fails to disclose:

o   *a storage device comprising*

    ▪   *a storage portion that stores the intermediate format file.* Clark does

        not disclose the conversion of input files to an intermediate format.

        However, Levine discloses *a storage device comprising a storage*

        portion that stores the intermediate format file (at least Pgs. 1-2,

        Paragraphs [0014-0025]; Figs. 1-3 → Levine, as depicted in Figure 1,

        converts the input book files to a solution-independent intermediate

        format (step 108), and stores the converted intermediate formatted

        files along with metadata such as the title, author, publisher, ISBN, and

        publication date (step 110) (interpreted as at least the *"metadata*

        related to the work itself" portion of the *"work metadata"* (see above

        discussion)).

        It would have been obvious to one of ordinary skill in the art at the

time of invention to combine the disclosures of Clark and Levine as

both inventions are related to the electronic dissemination of

documents such as books. Adding the disclosure of <u>Levine</u> provides

the benefit to <u>Clark</u> of storing the "converted intermediate format files"

and related "work metadata" from which multiple other forms and

formats of output can be generated.

<u>Clark</u> continues by disclosing:

o   *a conversion module that generates two or more editions of a work having*

   different formats, the two or more editions of the work being generated

   based on the intermediate format file and the work metadata (Col. 4, lines

   12-19; lines 55-61; Col. 7, lines 8-67 → the system can produce <u>both</u>

   <u>hardcopy</u> (print on demand) and <u>electronic</u> versions of output based on

   the input files and their associated metadata, where the metadata includes

   content about the publication as well as Digital Rights Management and

   publication instructions).

   It is noted that <u>Levine</u> is also capable of generating multiple forms

of output from the converted, stored intermediate format files and

associated work metadata (see Figure 1, steps 114, 202 (Figure 2), 302

(Figure 3)).

   It is further noted that the current claim language above describing

the generation of "*two or more editions of a work having different formats*"

<u>does not exclude</u> a system capable of generating multiple, different

formatted outputs (e.g., had copy, or ebook) as both Clark and Levine

teach.

In regard to dependent Claim 2, <u>Clark</u> discloses:

- *the storage device further comprises a storage portion that stores a piece of form metadata associated with the intermediate format file, the form metadata specifying a form of an edition of the work* (Col. 2, lines 15-22 → the method includes storing the metadata with metadata associated with other received electronic content, selecting metadata from the stored metadata that corresponds to electronic content authorized for a retailer, and storing at least a portion of the selected metadata for transmission to the retailer over the network in accordance with formatting information received from the retailer). (Col. 3, lines 2-13 → The metadata can include identifier information such as the ISBN, UPC or DOI of the work; pricing information for one or more markets in which the work may be sold; bibliographic information such as the author and title of the work; distribution information such as identification of territories where selling the work is authorized, retailers authorized to sell the work, and/or identification of one or more digital rights management systems for protecting the work when distributed electronically; and/or *manufacturing information, such as a printing and/or binding specifications, for use in the preparation of hard copies of the work* (i.e. *"form metadata"*). See also discussion in rejection of Claim 1 above.

In regard to dependent Claim 3, <u>Clark</u> discloses:

- *a distribution module that distributes the one or more editions of the work* (Figs. -
  23 → describe distribution mechanisms for the system).

In regard to dependent Claim 4, <u>Clark</u> discloses:

- *a plurality of distribution channels, wherein each distribution channel receives a
  different edition of the work* (Col. 7, lines 7-33 → describe distribution path for a
  hard copy distribution of a work. Col. 7, lines 34-62 → describe a distribution path
  for an electronic version of a work (e.g., e-book)).

In regard to dependent Claim 5, <u>Clark</u>, discloses:

- *the distribution module further comprises a web site into which the one or more
  editions of the work are loaded wherein the one or more editions of the work are
  available for download from the web site* (Col. 9, lines 45-47 → the server *may*
  provide a web site for distribution of works, though it is usually handled by
  another party).

In regard to dependent Claim 6, <u>Clark</u> discloses:

- *the distribution module distributes the one or more editions of the work to a
  wireless device* (Col. 9, lines 45-47 → the server *may* provide a web site for
  distribution of works, though it is usually handled by another party). <u>Clark</u> does
  not explicitly disclose distribution to a "wireless" device. However, since <u>Clark</u>

can distribute content via a web site, and also contemplates the electronic

distribution of content to a variety of devices including PDA and cell phones (see

Col. 1, lines 21-36), many of which were known to those of ordinary skill in the art

at the time of invention to have the ability to communicate wirelessly to web sites,

one of ordinary skill in the art at the time of invention would conclude that Clark

would have been able to distribute content wirelessly, providing the benefit of

instantaneous access to desired content from a web site.

In regard to dependent Claim 7, Clark discloses:

* *the distribution module distributes the one or more editions of the work over a*

  Bluetooth communications link Col. 9, lines 45-47 → the server *may* provide a

  web site for distribution of works, though it is usually handled by another party).

  Clark does not explicitly disclose distribution to a "wireless" device over

  "Bluetooth link". However, since Clark can distribute content via a web site, and

  also contemplates the electronic distribution of content to a variety of devices

  including PDA and cell phones (see Col. 1, lines 21-36), many of which were

  known to those of ordinary skill in the art at the time of invention to have the

  ability to communicate wirelessly (e.g., via normal cellular wireless means, and

  Bluetooth), one of ordinary skill in the art at the time of invention would conclude

  that Clark would have been able to distribute content wirelessly, providing the

  benefit of instantaneous access to desired content from a web site.

In regard to dependent Claim 10, <u>Clark</u> discloses:

Note: the Specification defines "work metadata" as consisting of a combination of

metadata related to the work itself and metadata related to the "final forms that the

Work might assume (form metadata)." Thus, the examiner considers a "subset" of

"work metadata" to be a portion of metadata that relates to style, format and/or

layout.

- *an edition of the work further comprises an edition containing a subset of the*

  work metadata associated with the intermediate format file (Col. 7, line 63

  through Col. 9, line 43 → discusses various incorporations of metadata to

  accompany a given title in a selected distribution format).

In regard to Claims 13-19, and 22, Claims 13-19, and 22 merely recite a computer-

implemented method for operating on the system of Claims 1-7, and 10,

respectively. Thus, the combination of <u>Clark</u> and <u>Levine</u> discloses every limitation of

Claims 13-19, and 22, as indicated in the above rejections for Claims 1-7, and 10.

In regard to Claims 25-31, and 34, Claims 25-31, and 34 merely recite a system for

operating on the system of Claims 1-7, and 10, respectively. Thus, the combination

of <u>Clark</u> and <u>Levine</u> discloses every limitation of Claims 25-31, and 34, as indicated

in the above rejections for Claims 1-7, and 10.

5.   Claims 8-9, 20-21, and 32-33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Clark in view of Levine, and in further view of Justice (U.S. Patent

Application Publication No. 2003/0023635 filed 07/25/2001, published 01/30/2003).

In regard to dependent Claim 8, <u>Clark</u> and <u>Levine</u> fail to disclose:

- *a template storage device that stores one or more templates that transform the*

  intermediate format file into an edition of the work.

    However, <u>Justice</u> discloses *a template storage device that stores one or more*

templates that transform the intermediate format file into an edition of the work (Fig.

8 → discloses the use of XSLT templates (style sheets) to provide conversion

means to transform input/intermediate files to output files in a specific format and

style).

    It would have been obvious to one of ordinary skill in the art at the time of

invention to combine the disclosures of <u>Clark</u>, <u>Levine</u>, and <u>Justice</u> as all three

inventions are related to the authoring, publication, and distribution of content via a

processing server and the Internet. Adding the disclosure of <u>Justice</u> provides the

benefit of utilizing XSLT templates to aid in the conversion from an intermediate

format to a final output format.

In regard to dependent Claim 9, <u>Clark</u> and <u>Levine</u> fail to disclose:

- *the template further comprises an XSLFO style sheet.*

    However, <u>Justice</u> discloses *the template further comprises an XSLFO style sheet*

(Fig. 8 → discloses the use of XSLT templates (style sheets) to provide conversion

means to transform input/intermediate files to output files in a specific format and style). Further, it was well known and obvious to those of ordinary skill in the art at the time of invention that an XSL-FO style sheet is one form of a style sheet akin to an XSLT/XSL style sheet (e.g., see K. Holman, "What is XSL-FO," 03/20/2002, Pg. 3 of 22, describes the relationship of XSL/XSLT/ and XSL-FO). Though Justice does not explicitly disclose the use of XSL-FO style sheets, Justice does disclose the storage and use of style sheets for processing input or intermediate content to final or output content. Thus, one of ordinary skill in the art at the time of invention would find it obvious to replace XSLT style sheets with XSL-FO style sheets, or to use both together since both would assist in rendering output content to the user.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Clark, Levine, and Justice as all three inventions are related to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the disclosure of Justice provides the benefit of utilizing XML-related templates (style sheets) to aid in the conversion from an intermediate format to a final output format.

In regard to Claims 20-21, Claims 20-21 merely recite a computer-implemented method for operating on the system of Claims 8-9, respectively. Thus, the combination of Clark, Levine, and Justice disclose every limitation of Claims 20-21, as indicated in the above rejections for Claims 8-9.

In regard to Claims 32-33, Claims 32-33 merely recite a system for operating on the system of Claims 8-9, respectively. Thus, the combination of <u>Clark</u>, <u>Levine</u>, and <u>Justice</u> disclose every limitation of Claims 20-21, as indicated in the above rejections for Claims 8-9.

Claims 11-12, 23-24, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Levine, and in further view of Barsness et al. (hereinafter Barsness, U.S. Patent Application Publication No. 2004/0201633 filed 09/13/2001, published 10/14/2004).

In regard to dependent Claim 11, <u>Clark</u> and <u>Levine</u> fail to disclose:

- *module that collects feedback about the editions of the work that are stored in the storage device.*

However, <u>Barsness</u> discloses *module that collects feedback about the editions of the work that are stored in the storage device* (Pg. 7, Paragraph [0085] → where the content is being created by an instructor, or any other author for that matter, the usage statistics may be utilized in revising the content, e.g., to simplify certain passages, make certain passages more understandable, etc., as shown in block 212. Once the content is revised, the content may optionally be redistributed to users as shown by the arrow from block 212 to block 204. The usage Statistics in this application are therefore utilized to assist an author in improving the quality of authored content based upon the usage statistic feedback generated by one or more users).

It would have been obvious to one of ordinary skill in the art at the time of

invention to combine, the disclosures of <u>Clark</u>, <u>Levine</u>, and <u>Barsness</u> as all of these

inventions relate to the authoring, publication, and distribution of content via a

processing server and the Internet. Adding the teaching of <u>Barsness</u> provides the

benefit of providing feedback to authors and publishers about their products' usage.

In regard to dependent Claim 12, <u>Clark</u> and <u>Levine</u> fail to disclose:

- *the feedback for an edition further comprises one or more of a number of copies*

  of an edition sold, a sales price of an edition, a geographic distribution of the

  edition and a demographics of final users of the edition.

  However, <u>Barsness</u> discloses *the feedback for an edition further comprises one*

or more of a number of copies of an edition sold, a sales price of an edition, a

geographic distribution of the edition and a demographics of final users of the edition

(Pg. 7, Paragraph [0085] → discloses the general use of usage statistics or

"feedback" between users of content and providers of content. For example, where

the content is being created by an instructor, or any other author for that matter, the

usage statistics may be utilized in revising the content, e.g., to simplify certain

passages, make certain passages more understandable, etc., as shown in block

212. Once the content is revised, the content may optionally be redistributed to

users as shown by the arrow from block 212 to block 204. The usage Statistics in

this application are therefore utilized to assist an author in improving the quality of

authored content based upon the usage statistic feedback generated by one or more users.

Barsness does appear to allow for a variety of other feedback from readers of the content and therefore it would have been obvious to those of ordinary skill in the art at the time of invention to conclude that at least demographical or geographic distribution information would be included among these feedbacks since one would have been able to glean such statistics, at least indirectly, from the manner of feedback received from individuals (e.g., the use of more complicated words might prompt someone who is less educated to provide feedback, where education is a demographic).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine, the disclosures of Clark, Levine, and Barsness as all of these inventions relate to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the teaching of Barsness provides the benefit of providing feedback to authors and publishers about their products' usage.

In regard to Claims 23-24, Claims 23-24 merely recite a computer-implemented method for operating on the system of Claims 11-12, respectively. Thus, the combination of Clark, Levine, and Barsness disclose every limitation of Claims 23-24, as indicated in the above rejections for Claims 11-12.

In regard to Claims 35-36, Claims 35-36 merely recite a system for operating on the system of Claims 11-12, respectively. Thus, the combination of <u>Clark</u>, <u>Levine</u>, and <u>Barsness</u> disclose every limitation of Claims 35-36, as indicated in the above rejections for Claims 11-12.

Response to Arguments

Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection. It is noted that the Examiner has reviewed the prior rejection made using the prior art of <u>Levine</u> and has concluded that it, in combination with Clark and other prior arts discloses all of the claimed limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is (571)272-4089. The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James H. Blackwell
07/14/2008

/Doug Hutton/
Doug Hutton
Supervisory Primary Examiner
Technology Center 2100